

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THOMAS C. KUKLO

Appeal No. 97-1840
Application No. 08/316,685¹

ON BRIEF

Before STAAB, NASE, and CRAWFORD, Administrative Patent Judges.

NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 20, which are all of the claims pending in this application.

¹ Application for patent filed September 30, 1994.

Appeal No. 97-1840
Application No. 08/316,685

We AFFIRM-IN-PART.

BACKGROUND

The appellant's invention relates to a concentric ring rotor. An understanding of the invention can be derived from a reading of exemplary claim 1, which appears in the appendix to the appellant's brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Pichl et al. (Pichl) 1980	4,241,620	Dec. 30,
Withers 1990	4,962,677	Oct. 16,
Andrä 1991	5,024,120	June 18,

Claims 1 through 20 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellant regards as the invention.

Claims 1 through 4, 9 through 11, 13 through 16 and 19 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Andrä.

Claims 5 through 8, 12 and 17 stand rejected under 35 U.S.C. § 103 as being unpatentable over Andrä in view of Withers.

Claims 18 and 20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Andrä in view of Pichl.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 12, mailed November 7, 1996) for the examiner's complete reasoning in support of the rejections, and to the appellant's brief (Paper No. 9, filed June 24, 1996) and reply brief (Paper No. 13, filed November 27, 1996) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the

examiner. As a consequence of our review, we make the determinations which follow.

Initially we note that the appellant's disagreement with the changes to the specification relates to a petitionable matter and not to an appealable matter. See Manual of Patent Examining Procedure (MPEP) §§ 1002 and 1201. Accordingly, we can not resolve the issue raised by the appellant on page 6 of the brief and page 3 of the reply brief. Nevertheless, we wish to note that the appellant's proposed changes to Figures 1 and 2 appear to be consistent with the originally filed specification while the examiner's changes to page 6, line 16 to page 7, line 4, introduce an inconsistency into the specification since the examiner failed to make similar changes to lines 5-18 of page 7.

The indefiniteness issue

We will not sustain the examiner's rejection of claims 1 through 20 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and

distinctly claim the subject matter which the appellant regards as the invention.

The second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity. In re Johnson, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977). In making this determination, the definiteness of the language employed in the claims must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. Id.

The examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. § 112, second paragraph, is whether the claims meet the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available. Some latitude in the manner of expression and the aptness of terms is permitted even though the claim language is not as

precise as the examiner might desire. If the scope of the invention sought to be patented cannot be determined from the language of the claims with a reasonable degree of certainty, a rejection of the claims under 35 U.S.C. § 112, second paragraph, is appropriate.

Thus, the failure to provide explicit antecedent basis for terms does not always render a claim indefinite. As stated above, if the scope of a claim would be reasonably ascertainable by those skilled in the art, then the claim is not indefinite. See Ex parte Porter, 25 USPQ2d 1144, 1145 (Bd. Pat. App. & Inter. 1992).

With this as background, we have reviewed the specific objections under 35 U.S.C. § 112, second paragraph, made by the examiner of the claims on appeal (answer, pp. 4-6). However, after reviewing the specific objections, we find ourselves in agreement with the position of the appellant (brief, pp. 7-8) that the scope of the claims under appeal can be determined from the language of the claims with a reasonable degree of certainty. In addition, it is our

opinion that with respect to claim 12 that one possessing the ordinary level of skill in this art would understand the "inner concentric ring" recited in line 2 to mean the "innermost ring" of the "concentric rings." Thus, a rejection of the claims under 35 U.S.C. § 112, second paragraph, is inappropriate and accordingly, the decision of the examiner to reject claims 1 through 20 under 35 U.S.C. § 112, second paragraph, is reversed.

The anticipation issue

We sustain the examiner's rejection of claims 1 through 4, 9 through 11, 13 through 16 and 19 under 35 U.S.C. § 102(b).

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.

Verdegaal Bros. Inc. v. Union Oil Co., 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir.), cert. denied, 484 U.S. 827 (1987). The inquiry as to whether a reference anticipates a claim must focus on what subject matter is encompassed by the

claim and what subject matter is described by the reference. As set forth by the court in Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984), it is only necessary for the claims to "'read on' something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or 'fully met' by it."

Claim 1

Claim 1 recites a concentric ring rotor assembly having at least one expandable separator/torque coupler operatively connected between at least two adjacent axially spaced concentric rings of the rotor assembly.

Claim 1 is anticipated by Andrä. Andrä discloses a torsional vibration damper. As shown in Figure 2, the torsional vibration damper comprises a central hub ring 1, which forms means for connecting the damper to the shaft which in use is connected to a part to be damped such as a shaft (not shown)

extending through aperture 1a, and an inertial ring 2 rotatable relative to central hub ring 1 about longitudinal axis of rotation x-x. The central hub ring 1 and inertial ring 2 are connected to each other via a damping element arranged in the radial space between the hub ring 1 and inertial ring 2. The damping element comprises an outer ring 3, flange ring 5 and an inner ring 4. The outer ring 3 is bonded to substantially axially opposed, adhesive surfaces 6, 7 of the inertial ring 2 and the flange ring 5, respectively. The inner ring 4 is bonded to substantially radially opposed, adhesive surfaces 8, 9, respectively, of the hub ring 1 and the flange ring 5.

It is our opinion that claim 1 "reads on" Andrä as follows: in a concentric ring rotor assembly (Andrä's torsional vibration damper is a rotor assembly having concentric rings (e.g., hub ring 1 and inertial ring 2)), the improvement comprising: at least one expandable separator/torque coupler (Andrä's damping element (i.e., outer ring 3, flange ring 5 and inner ring 4)) operatively connected between at least two adjacent axially spaced concentric rings

(Andrä's hub ring 1 and inertial ring 2) of the rotor assembly.

The argument presented by the appellant (brief, pp. 8-10) is unpersuasive for the following reasons.

First, the appellant argues that the concentric rings of Andrä are radially spaced, not axially spaced as claimed and disclosed.² We do not agree. As shown in the appellant's Figures 1 and 2, the three concentric rings 10, 11, 12 rotate about the axis/centerline 13 with each ring spaced at a different radial distance from the axis/centerline 13. In addition, the appellant describes (specification, pp. 6-7) the lower end 23 of each separator 19, 20 as extending radially outwardly and that the separators 19, 20 provide for radial expansion of the rings. In similar fashion, Andrä has hub ring 1 and inertial ring 2 which rotate about the axis x-x with the inertial ring 2 and hub ring 1 spaced at different

² The phrase "axially spaced" was introduced by the appellant in the amendment filed on November 20, 1995 (Paper No. 4).

radial distances from the axis x-x. In view of these facts, we conclude that Andrä's hub ring 1 and inertial ring 2 are axially spaced in the same manner that the appellant's rings 10, 11, 12 are axially spaced.

Second, the appellant argues that Andrä's device is not a concentric ring rotor as known in the art. We do not agree. As clearly shown in Figure 2 of Andrä, the hub ring 1 and inertial ring 2 define concentric rings and since Andrä's torsional vibration damper is a rotating part of a mechanical device it constitutes a rotor.

Third, the appellant argues that there is no teaching in Andrä of at least one expandable separator which functions as a torque converter as defined in claim 1. We do not agree. In our view, the claimed expandable separator/torque coupler "reads on" Andrä's damping element (i.e., outer ring 3, flange ring 5 and inner ring 4) arranged in the radial space between the hub ring 1 and the inertial ring 2. In that regard, the damping element (1) transmits torque between the hub ring 1 and the inertial ring 2, (2) separates the hub ring 1 and the

inertial ring 2 , and (3) is expandable due to the elastomeric nature of the outer ring 3 and inner ring 4 (see claims 9 and 10 of Andrä).

For the reasons set forth above, the decision of the examiner to reject claim 1 under 35 U.S.C. § 102(b) is affirmed.

Claims 2 and 3

With respect to dependent claims 2 and 3, the appellant argues (brief, p. 10) that Andrä lacks (1) the multiple axial spaced concentric rings with separators therebetween as recited in claim 2, and (2) an expandable separator extending from the top of one of the rings to the bottom of the adjacent ring as recited in claim 3.

We find these arguments to be unpersuasive for the following reasons.

First, claim 2 is readable on a device having only two rings and one separator therebetween. As such claim 2 reads

on Andrä in the same manner as set forth above with respect to parent claim 1. Additionally, we agree with the examiner that it is appropriate to consider Andrä's flange ring 5, hub ring 1 and inertia ring 2 as multiple axially spaced concentric rings with separators (i.e., outer ring 3 and inner ring 4) therebetween.

Second, claim 3 reads on Andrä's damping element (i.e., outer ring 3, flange ring 5 and inner ring 4) since it extends from the top of the hub ring 1 to the bottom of the inertial ring 2. This is shown when viewing Andrä's Figure 2 and rotating the figure 90°.

For the reasons set forth above, the decision of the examiner to reject claims 2 and 3 under 35 U.S.C. § 102(b) is affirmed.

Claims 4, 9 through 11, 13 through 16 and 19

Claims 4, 9 through 11, 13 through 16 and 19 have not been separately argued by the appellant. Accordingly, these claims will be treated as falling with claim 1. See In re

Young, 927 F.2d 588, 590, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991); In re Nielson, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987); and In re Wood, 582 F.2d 638, 642, 199 USPQ 137, 140 (CCPA 1978). Thus, it follows that the decision of the examiner to reject claims 4, 9 through 11, 13 through 16 and 19 under 35 U.S.C. § 102(b) is also affirmed.

The obviousness issues

We sustain the examiner's rejection of claims 18 and 20 under 35 U.S.C. § 103 but not the rejection of claims 5 through 8, 12 and 17.

The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. See In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

Claims 18 and 20

The appellant has not contested the examiner's modification of Andrä by the teachings of Pichl (answer, pp. 8-9). The appellant's only argument (brief, p. 12) with regard to this rejection is that neither reference teaches adjacent axially spaced concentric rings. This argument is unpersuasive with respect to Andrä for the reasons set forth above with respect to claim 1. Accordingly, the decision of the examiner to reject claims 18 and 20 under 35 U.S.C. § 103 is affirmed.

Claims 5 through 8, 12 and 17

Claims 5 through 8, 12 and 17 recite a cut-away (claims 5-8), a cut-away section (claim 12), or a cut-away inner end (claim 17).

The appellant argues (brief, pp. 10-12) that there is no suggestion in the references themselves for the examiner's modification of Andrä by the teachings of Withers (answer, pp. 7-8). We agree. Obviousness is tested by "what the combined

teachings of the references would have suggested to those of ordinary skill in the art." In re Keller, supra. But it "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). And "teachings of references can be combined only if there is some suggestion or incentive to do so." Id. Here, the prior art contains none. Instead, it appears to us that the examiner relied on impermissible hindsight in reaching her obviousness determination. Since the cut-away limitation as recited in claims 5 through 8, 12 and 17 is not taught or suggested by the applied prior art, the decision of the examiner to reject claims 5 through 8, 12 and 17 under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 through 20 under 35 U.S.C. § 112, second paragraph, is reversed; the decision of the examiner to reject claims 1 through 4, 9 through 11, 13 through 16 and 19 under 35 U.S.C. § 102(b) is affirmed; the decision of the examiner to reject

claims 5 through 8, 12 and 17 under 35 U.S.C. § 103 is
reversed; and the decision of the examiner to reject claims 18
and 20 under
35 U.S.C. § 103 is affirmed.

No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a).

AFFIRMED-IN-PART

LAWRENCE J. STAAB)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JEFFREY V. NASE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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MURRIEL E. CRAWFORD)	
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Appeal No. 97-1840
Application No. 08/316,685

Page 20

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APPEAL NO. 97-1840 - JUDGE NASE
APPLICATION NO. 08/316,685

APJ NASE

APJ STAAB

APJ CRAWFORD

DECISION: **AFFIRMED-IN-PART**

Prepared By: Gloria Henderson

DRAFT TYPED: October 1, 1998

FINAL TYPED: